**Merely Informational Matter Examination Guide – Response to Public Comments**

Thank you to all who submitted comments. These insightful and constructive comments aided the USPTO in producing a final version of the examination exam guide that provides a clearer explanation of the relevant examination policies and procedures.

In order to more efficiently respond to the comments received, we are posting a single, comprehensive response here.

**Legal Authority**

Some of the comments we received questioned the legal authority for this refusal. The failure-to-function refusal is based on §§1, 2, & 45 or §§1, 2, 3, & 45 of the Trademark Act, and, in particular, the definition of “trademark.” The refusal is used for matter that would not be perceived by relevant consumers as indicating the source of the goods or services or as a means to identify and distinguish the applicant’s goods or services from those of others. TMEP §1202. The exam guide is intended to clarify and augment the existing policies and procedures for examining certain types of matter that do not meet the statutory definition of a trademark and thus fail to function as marks. As set out in TMEP §1202.04, one reason that matter may fail to function as a mark, and thereby fail to meet the definition of a trademark, is because it would be perceived merely as non-source indicating informational matter. This exam guide categorizes some types of matter that may be considered “merely informational” in order to provide more detailed guidance to examining attorneys and examples illustrating what is covered by the refusal.

**Application of Refusal**

Some comments expressed concerns regarding potential inconsistent use of the refusal by examining attorneys, the types and amounts of evidence needed to support the refusal, and the types and amounts of evidence needed to overcome the refusal.

The exam guide is designed to facilitate more consistent application of the merely informational failure-to-function refusal. As discussed in the guide, there is no set amount of evidence needed to issue or to overcome such a refusal. The discussion of the evidence is intended to provide helpful examples of the nature and typical types of evidence relevant to supporting the refusal, while still allowing some flexibility in the type and amount of evidence that will suffice to establish a reasonable basis for issuing the refusal. Each mark must be considered on its own merits and the specific facts involved. As with all refusals, an examining attorney is expected to rely on all of the available evidence to form his or her own judgment.

Examining attorneys have received further training on the policies and procedures in this exam guide. This guidance will aid them in determining how to apply the principles of law discussed in this exam guide.

**Distinguishing Refusals**

Some comments asked for further clarification of the differences between the following refusals: incapable informational matter, generic matter, and descriptive matter.

There is some overlap in the rationale for these refusals. For example, one purpose of each of the refusals is to ensure that elements of the mark that tell the consumers something directly about the relevant goods or services remain available for use by competitors to tell consumers the same thing about their own goods or services. Another rationale underlying generic and merely informational refusals is that the matter cannot be registered because it does not serve to indicate source, and thus, fails to function as a trademark.

However, there are differences in the legal tests that apply and the evidence necessary to support a given refusal. The applicability of each of the refusals will depend entirely upon the factual circumstances of each case, including the mark, the identified goods or services, the meaning of the matter in the applied-for mark, and marketplace use at the time of examination. A given mark may receive one or all of these refusals depending on the record developed during examination.

The exam guide has been revised to provide additional information regarding distinctions between merely informational, merely descriptive, and generic matter. Furthermore, examining attorneys received training to assist them in determining which refusal may apply when examining applications.

**Diversity of Examples**

One comment referred to the lack of diversity in examples in the section of the exam guide discussing religious texts. To maximize the utility of the exam guide, we strived to provide guidance on the kinds of examples our examination staff is likely to encounter. Thus, the types of examples generally reflect the types of examples the agency has tended in recent years to see in applications.

**Typographical Errors**

Some comments identified typographical errors in the exam guide. Any identified errors in the exam guide were corrected.

**Word Choice and Text Formatting Edits**

Some comments suggested changes in word choice and text formatting in the exam guide. All suggestions were carefully considered in crafting the final version of the exam guide.